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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,536	02/17/2006	Kohei Suzuki	043888-0439	4534
53080 7590 03/31/2010 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, NW WASHINGTON, DC 20005-3096				
EXAMINER				
LEE, CYNTHIA K				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,536

Applicant(s)

SUZUKI ET AL.

Examiner

CYNTHIA LEE

Art Unit

1795

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 8-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/9/2010 has been entered.

Response to Amendment

This Office Action is responsive to the amendment filed on 3/9/2010. Claims 5-7 have been canceled and claims 17 and 18 have been added. Claims 1-3 and 8-16 are pending. Applicant's arguments have been considered. Claims 1-3 and 8-18 are non-finally rejected for reasons stated herein below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 8-10, 13, 14, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 2002/0037450) in view of Delnick (US 5948464), Xie (US 5928812), and Kizu (US 2003/0165739).

Suzuki discloses a lithium ion secondary battery comprising:
a positive electrode capable of absorbing and desorbing lithium ion [0030];
a negative electrode capable of absorbing and desorbing lithium ion [0054];
a porous film interposed between said positive electrode and said negative electrode; and a non-aqueous electrolyte [0055];
wherein said porous film is adhered to a surface of at least said negative electrode [0055],

Suzuki discloses a porous film, but does not disclose said porous film comprises an inorganic filler and a first binder, a content of said first binder in said porous film being 1.5 to 8 parts by weight per 100 parts by weight of said filler. Delnick teaches a separator comprising inorganic filler (6:46-60) and a binder 34 (7:5-15). The separator provides good performance in a very thin thickness regime, thereby allowing cell scalability to dimensions previously unattainable and performance surpassing that of prior separators that contain particulate reinforcements (6:20-25).

Regarding claim 8, Delnick teaches said inorganic filler comprises an inorganic oxide (6:45-60).

Regarding claim 10, Delnick teaches that said inorganic oxide includes alumina and titanium oxide (6:49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the separator of Suzuki of inorganic solid particulate as taught by Delnick for the benefit of obtain a good performing separator with thin dimensions. The ratio of binder to solid particulate is 5/95 to 10/90 (7:27). MPEP states

that prior art which teaches a range overlapping or touching the claimed range anticipates if the prior art range discloses the claimed range with "sufficient specificity."
See 2131.03

Regarding claim 1, Delnick teaches using PVC, PVDF, or EPDM as binders but does not disclose said first binder comprises a first rubber of an acrylonitrile unit, said first rubber being water-insoluble and having a decomposition temperature of 250°C or higher. Regarding claim 3, Delnick does not disclose said first rubber includes a polyacrylonitrile chain. Xie teaches that a separator can use polyacrylonitrile as a binder (7:24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use polyacrylonitrile as a binder in the separator of Delnick since it has been held by the court that the selection of a known material based on its suitability for its intended use is *prima facie* obvious. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

Regarding the limitation "water-insoluble and having a decomposition temperature of 250°C or higher" in claim 1, it is an inherent property of polyacrylonitrile. See the instant Specification pg 16, last paragraph. A reference which is silent about a claimed invention's features is inherently anticipatory if the missing feature is *necessarily present in that which is described in the reference*. In re Robertson, 49 USPQ2d 1949 (1999).

Regarding claim 1, Suzuki discloses said negative electrode comprises a negative electrode active material capable of absorbing and desorbing lithium ion and a second binder [0054], said second binder includes a second rubber particle including a

styrene unit and a butadiene unit and a water-soluble polymer including a methylcellulose unit [0076].

Regarding claim 1, Suzuki discloses a content of said second binder in said negative electrode is 4.3 parts by weight per 100 parts by weight of said negative electrode active material [0076], and not 1.5 to 3 parts. Kizu teaches a binder is added in a proportion of preferably 1 wt %-15 wt %, to a negative electrode active material composition. When the amount of the binder is lower than 1 wt %, the adhesion between the negative electrode active material layer and the current collector becomes insufficient to permit easy release, as a result of which the cycle characteristic is unpreferably and inconveniently degraded. When the amount of the binder exceeds 15 wt %; an excess presence of the binder in the negative electrode active material layer, which is an insulator, increases the electrode resistance and the cycle characteristic and rate characteristic are inconveniently preferably degraded [0159]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the amount of binder in the negative electrode of Suzuki, as taught by Kizu, for the benefit of properly binding the negative active material. Kizu clearly teaches that the amount of binder is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Regarding claim 9, the inorganic filler of Delnick is alkaline on the surface because the separator comprising the inorganic filler is in direct contact with the electrolyte, and the electrolyte contains alkaline ions [0059].

Regarding claim 9, Delnick does not expressly teach that said inorganic oxide has a specific surface area. It is noted that surface area (m^2/g) is equal to $m^3/(mass \cdot length)$ or $1/(density \cdot length)$. It is also noted that density is constant. Delnick teaches that that solid particulate size ranges from 0.01 μm to 1.0 μm (6:65-67). Delnick teaches that modifications can be made to the mixture to improve its dispersion and sizes suitable for the preferred printing processes (7:1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the particle size of the solid particulate for the benefit of obtaining a good dispersion.

Regarding claim 13, Suzuki discloses wherein said positive electrode and said negative electrode are wound with said porous film interposed therebetween [0055].

Regarding claim 14, Delnick teaches the separator thickness as being between 5-100 μm (9:17). In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP 2144.05.

Regarding claim 17, the inorganic filler of Delnick is alkaline on the surface because the separator comprising the inorganic filler is in direct contact with the electrolyte, and the electrolyte contains alkaline ions [0059].

Regarding claim 18, Delnick teaches using PVC, PVDF, or EPDM as binders but does not disclose said first rubber comprises core-shell type particles of acrylonitrile-acrylate copolymer, and said acrylate forms an acidic adhesive surface portion on a surface of the core-shell type particles. Suzuki discloses a core-shell type rubber particle binder comprising an acrylonitrile-acrylate copolymer in a positive electrode [0031]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the binder as a separator binder as well since it has been held by the court that the selection of a known material based on its suitability for its intended use is *prima facie* obvious. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07. The core-shell type rubber particle comprising an acrylonitrile-acrylate copolymer has an acidic adhesive surface because it meets the structural limitations of Applicant's porous film.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 2002/0037450) in view of Delnick (US 5948464), Xie (US 5928812), and Kizu (US 2003/0165739) as applied to claim 1, as evidenced by the melting point of polyacrylonitrile, retrieved from <http://scientificpolymer.com/catalog/description.asp?QProductCode=134> on 3/27/2010.

Suzuki modified by Delnick, Xie, and Kizu teaches all the limitations of claim 1 and are incorporated herein. Regarding claim 2, it is noted that polyacrylonitrile of Xie

inherently possesses a crystalline melting point of 250 °C or more. Refer to the product description of polyacrylonitrile attached.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 2002/0037450) in view of Delnick (US 5948464), Xie (US 5928812), and Kizu (US 2003/0165739) as applied to claim 1, further in view of Ota (US 6365300).

Suzuki modified by Delnick, Xie, and Kizu teaches all the limitations of claim 1 and are incorporated herein. Suzuki modified by Delnick, Xie, and Kizu does not disclose wherein a surface roughness of said porous film is less than a surface roughness of an electrode surface to which said porous film is adhered to. Ota teaches that surface roughness (R_{max}) of the negative electrode affects the battery performance considerably. It is desirable that the value of R_{max} be not less than 0.01 μm and not more than 5 μm . If less than 0.01 μm , good bonding with the electrolytic layer cannot be obtained, resulting in easy separation. In addition, smooth deposition and ionization of the metallic lithium may not be performed at the time of charge and discharge. It appears that the deposition and ionization are affected by the bonding with the electrolytic layer (10:1-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to roughen the surface of the electrodes of Delnick, Xie, and Kizu for the benefit of good bonding between the electrode and the separator. It is noted that the combination of Suzuki modified by Delnick, Xie, and Kizu would roughen the surface of the electrodes, but the porous film,

and thus reads on Applicant's "surface roughness of said porous film is less than a surface roughness of an electrode surface to which said porous film is adhered to."

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 2002/0037450) in view of Delnick (US 5948464), Xie (US 5928812), and Kizu (US 2003/0165739) as applied to claim 1, further in view of Hampden-Smith (US 2002/0168570).

Suzuki modified by Delnick, Xie, and Kizu teaches all the limitations of claim 1 and are incorporated herein. Suzuki modified by Delnick, Xie, and Kizu does not disclose a mixture of a large particle group and a small particle group of the inorganic filler. Hampden-Smith teaches of providing a battery powder batch having a bimodal particle size distribution. That is, the powder batch can include battery particles having two distinct and different average particle sizes. A bimodal particle size distribution can enhance the packing efficiency of the powder which is important for use as a battery electrode [0168]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the inorganic fillers of Suzuki modified by Delnick, Xie, and Kizu with two distinct particle sizes as taught by Hampden-Smith for the benefit of good packing ability.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 2002/0037450) in view of Delnick (US 5948464), Xie (US 5928812),

and Kizu (US 2003/0165739) as applied to claim 1, further in view of Daroux (US 6562511).

Suzuki modified by Delnick teaches all the limitations of claim 1 and are incorporated herein. Suzuki modified by Delnick does not disclose a separator is further interposed between said positive electrode and said negative electrode. Daroux teaches a separator for a Li-ion polymer battery comprised of a plurality of separator layers that are laminated together. The plurality of separator layers including a first layer formed of a first separator material, and a second layer formed of a second separator material, wherein the second layer is compositionally and structurally different from the first layer. See Abstract. The thickness of each separator is about 15 μ m to about 35 μ m (4:10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the battery of Suzuki of two separators, as taught by Daroux, for the benefit of providing reinforced protection against puncture.

Response to Arguments

Applicant's arguments filed 3/9/2010 have been fully considered.

Applicant's arguments with respect to the rejection regarding Suzuki's binder amount have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Xie.

Applicant argues that Suzuki uses a core-shell type particle binder over PVDF so that the core-shell type particle binders can cover a large area without adding a large amount. Applicant argues that this is not an issue with separators. Therefore, one skilled in the art would not be motivated to use the core-shell particles used as the positive electrode binder of Suzuki as the separator binder of Delnick.

In response, it is noted that core-shell type particle binders are not only good for covering large surface areas in positive electrodes, but Suzuki teaches particle binders possess a balance between the stickiness and elasticity [0033]. Thus, core-shell type particle binders are not solely limited to use electrodes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Lee whose telephone number is 571-272-8699. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cynthia Lee/

Examiner, Art Unit 1795